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Supreme Court of the United States

October Term, 1973

73-1164

DEERING MILLIKEN RESEARCH CORPORATION, *Petitioner*

v.

THE DUPLAN CORPORATION, *et al.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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DEERING MILLIKEN RESEARCH CORPORATION, *Petitioner*

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THE DUPLAN CORPORATION, *et al.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

The petitioner prays that a writ of certiorari issue to review a judgment of the United States Court of Appeals for the Fourth Circuit entered September 27, 1973. The Court of Appeals affirmed a judgment of the United States District Court for the District of South Carolina granting summary judgment to the respondents on their claim that two United States patents are invalid; it thereby held that a foreign patent application which remains secret by force of law may nevertheless be a statutory bar to a United States patent.

Certiorari is warranted because the courts below adopted a misinterpretation of the law which could have a severe impact on the administration of the patent system.

Opinions Below

The opinion of the court of appeals, dated September 27, 1973, is reported at 179 U.S.P.Q. 449 (A1).[1] An opinion and order of the district court dated January 2, 1973 are reported at 353 F. Supp. 826 (A5). A further order of the district court dated February 21, 1973 is reported at 177 U.S.P.Q. 515 (A27).

Jurisdiction

The judgment of the court of appeals was entered September 27, 1973 (A1). A timely petition for rehearing with suggestion for rehearing *en banc* was filed October 24, 1973. An order denying the petition for rehearing was entered November 1, 1973 (A35). The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

Question Presented

Can an invention which is not accessible as of right to the public be deemed "patented" in a foreign country by virtue of a secret ministerial act, so as to bar a United States patent for the same invention?

Statute Involved

35 U.S.C. §102 is set forth in the appendix to this petition (A36).

1. "A" references are to the appendix to this petition.

Statement

For more than a century it has been a requirement of United States patent law that a patent be open to the public if it is to be set up as a statutory bar to an otherwise allowable United States patent application. The courts below have discarded this requirement, thus jeopardizing countless patents and sowing confusion in a critical section of the patent law.

The present petition arises from a consolidated patent-antitrust litigation pending in the United States District Court for the District of South Carolina. The petitioner, the exclusive United States use licensee of the patents in question, is the plaintiff in some of the consolidated proceedings and a defendant in others. Petitioner asserts patent infringement claims, and claims for breach of patent license agreements, against 17 firms (the so-called "throwsters") engaged in texturizing, or "throwing," yarn. The throwsters in turn seek declaratory judgments that the patents at issue are invalid and not infringed; they also assert antitrust claims against the petitioner and others. The jurisdiction of the district court is invoked under 15 U.S.C. §15 and 28 U.S.C. §§1331, 1332, and 1338.

The throwsters moved for summary judgment that two United States patents at issue were invalid under 35 U.S.C. §102(d) on the ground that the inventions they described were patented in France before the filing of the respective United States applications. The throwsters did not dispute that the inventions had not been disclosed to the public on the United States application date. The district court

granted the motion for summary judgment, and the court of appeals affirmed.

The controlling statute, 35 U.S.C. §102, provides in pertinent part:

> "A person shall be entitled to a patent unless—
>
> "(a) the invention was known or used by others in this country, or *patented* or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
>
> "(b) the invention was *patented* or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
>
> * * *
>
> "(d) the invention was first *patented* or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States * * *." [Emphasis supplied.][2]

The sole issue presented by this petition is the meaning of the word "patented" in §102, and in particular in subsection (d).

The applications for the French counterparts of the patents at issue were filed more than 12 months before the United States applications. The parties dispute whether the inventions were "patented" in France within the mean-

2. The references to the inventor's certificate in §102(d), which have no bearing here, were added to the statute subsequent to the events at issue on this petition.

ing of §102(d) on the *délivré* date, which preceded the United States applications, or on the publication date, which followed the United States applications. On the *délivré* date, a decree of issuance was executed in the French patent office, but the patent specification remained secret by operation of French law. The specification was not laid open for public inspection until approximately five weeks after *délivré*, coincident with the publication of notice of the patent in the *Bulletin Officiel de la Propriété Industrielle.*

The significance of publication is demonstrated by comparing the French patenting procedure to our own. In the United States, when the Patent Office decides to issue a patent, it sends a notice of allowance to the applicant; this corresponds to the French *délivré.* But the invention is not patented and the specification remains closed to public inspection until a later date, when a public document embodying the grant of exclusive proprietary rights issues from the Patent Office and simultaneously a notice and description are published in the Official Gazette.[3]

The parties here and the courts below all agree that if the publication date controls, the inventions were not "patented" in France before the United States applications and so do not bar the United States patents. The parties

3. The following chronology shows the relevant dates for the United States and French patents under consideration:

	U.S. Patent 3,137,119	*U.S. Patent 3,382,656*
French Application	June 8, 1960	November 13, 1964
French *Délivré*	June 12, 1961	December 27, 1965
United States Application	June 14, 1961	January 3, 1966
French Patent Publication	July 21, 1961	February 4, 1966

and courts further agree that the publication date is the first date upon which the contents of each French patent became available to the public as a matter of French patent law procedure. Moreover, it cannot seriously be disputed that the inventions were not "patented" in France within the meaning of 35 U.S.C. §§102(a) and 102(b) until the publication date.

Nonetheless, the courts below held that the unavailability of the foreign patent specification to the public on the *délivré* date made no difference, and that the signing of the French decree on that date triggered the statutory bar established by §102(d).

Reasons for Granting the Writ

As a reading of 35 U.S.C. §§102(a), (b), and (d) (quoted *supra*, at 4) makes clear, the word "patented" is frequently the key to determining when a reference will bar issuance of a United States patent. The importance of this question is self-evident. In particular, the effect under §102 of foreign references, such as those involved in this case, is of large and growing practical importance. Although an analysis of counterpart patenting in foreign countries and the United States does not appear to be available, the Patent Office reports that in 1971 alone some 33,000 United States patent applications were filed by residents of foreign countries; of these, nearly 3,000 were French. Commissioner of Patents, *Annual Report for Fiscal Year 1972*, at 23-24.

Thus, it is vital that the established interpretation of "patented," as it relates to foreign references, be clear

and consistent. It was clear and consistent until the decisions below. Until then, it was well established that the term "patented," as used throughout §102, connoted not only the grant of exclusive proprietary rights but also disclosure of the invention to the public.[4] A patent is, by definition, a public document.[5]

The decisions below change the law by permitting foreign reference to bar a United States patent even though the foreign reference is, by operation of foreign law, secret from the public; yet the court of appeals has not attempted to justify this extraordinary result, beyond the cursory statement that "the exclusive rights which the nature of a patent includes and envisions accrue to the inventor in France on the date of delivery rather than on the date of publication" (A2-A3).

Whether there is justification for such a departure from precedent in so important a statute should, we submit, be considered by this Court. No adequate justification appears either in the opinions or in the arguments made by the throwsters below.

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4. *E.g., Elizabeth* v. *Pavement Co.*, 7 Otto (97 U.S.) 126, 130 (1877) (predecessor to §102(a)); *Carter Products, Inc.* v. *Colgate-Palmolive Co.*, 130 F. Supp. 557, 564 (D. Md. 1955), *aff'd on other grounds*, 230 F.2d 855 (4th Cir.), *cert. denied*, 352 U.S. 843 (1956) (§102(a)); *In re Ekenstam*, 256 F.2d 321, 323-25 (C.C.P.A. 1958) (§102(b)); *American Infra-Red Radiant Co.* v. *Lambert Industries, Inc.*, 360 F.2d 977, 991-94 (8th Cir.), *cert. denied*, 385 U.S. 920 (1966) (§102(d)); *Ex parte Rackham*, 306 O.G. Pat. Off. 243 (Comm. Pat. 1922) (predecessor to §102(d)).

5. *In re Ekenstam, supra*, 256 F.2d at 323-24; *American Infra-Red Radiant Co.* v. *Lambert Industries, Inc., supra*, 360 F.2d at 994; *Schoerken* v. *Swift & Courtney & Beecher Co.*, 7 F. 469, 471-72 (C.C.S.D.N.Y. 1881).

A. The Decisions Below Needlessly Reject the Established Meaning of "Patented" in 35 U.S.C. §102.

The decisions below clearly hold that availability to the public is not an element of "patented" as that word is used in §102(d). It is not clear whether this holding extends to subsections (a) and (b) also—or whether the courts below view "patented" as retaining its established meaning under the two earlier subsections, while taking on a different meaning fifty words later in subsection (d). Certain language in the district court opinion (A16-A17) seems to distinguish §102(d) from the earlier subsections; but the decisions on which the district court primarily relied (A14-A15) arose under 35 U.S.C. §§102(a) and (b).[6] Likewise, the court of appeals refrained from stating whether its decision went beyond §102(d)—but one of the two cases it cites is a §102(a) case.[7]

Either the broader or the narrower holding would be inconsistent with prior law, as set forth in decisions of courts of appeals and district courts and in internal Patent Office rulings.

It is surely far too late to contend—and, indeed, the throwsters did not contend below—that the element of

6. *Sun Rubber Co.* v. *National Latex Products Co.*, 148 F. Supp. 469 (N.D. Ohio 1957), *aff'd in part, rev'd in part*, 274 F.2d 224 (6th Cir. 1959), *cert. denied*, 362 U.S. 989 (1960); *General Electric Co.* v. *Hygrade Sylvania Corp.*, 61 F. Supp. 476, 529 (S.D.N.Y. 1944); *Sirocco Engineering Co.* v. *B.F. Sturtevant Co.*, 220 F. 137 (2d Cir. 1914), *cert. denied*, 238 U.S. 636 (1915); *Ritter* v. *Rohm & Haas Co.*, 271 F. Supp. 313 (S.D.N.Y. 1967).

7. *Ritter* v. *Rohm & Haas Co.*, 271 F. Supp. 313 (S.D.N.Y. 1967).

availability to the public can be read out of the word "patented" throughout 35 U.S.C. §102. Sound authorities dating from 1851 to the present expressly hold that availability to the public is required. In *Brooks* v. *Norcross*, 4 F. Cas. 294, 296 (No. 1,957) (C.C.D. Mass. 1851), it was said, "The word 'patented' . . . must of course mean covered and *made known to the world* by a *public patent*, so as to bring home to the public . . . a knowledge of its existence . . . ." (Emphasis added). *Schoerken* v. *Swift & Courtney & Beecher Co.*, 7 F. 469, 471 (C.C.S.D.N.Y. 1881), held that an invention is not "patented" unless it is "laid open to the public." As *In re Ekenstam*, 256 F.2d 321, 323 (C.C. P.A. 1958), pointed out, "The word 'patent' is derived from the Latin 'patere,' meaning 'to be open,' and the significance of 'open' is still commonly attached to that word." To the same effect, see *Elizabeth* v. *Pavement Co.*, 7 Otto (97 U.S.) 126, 130 (1877); *Carter Products, Inc.* v. *Colgate-Palmolive Co.*, 130 F. Supp. 557, 564 (D. Md. 1955), *aff'd on other grounds*, 230 F.2d 855 (4th Cir.), *cert. denied*, 352 U.S. 843 (1956); *Ex parte Rackham*, 306 O.G. Pat. Off. 243, 244 (Comm. Pat. 1922).

There is no authority to the contrary of any substance. The cases principally relied on by the courts below either give no reasoned consideration to the issue,[8] or concern

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8. *Sun Rubber Co.* v. *National Latex Products Co.*, 148 F. Supp. 469 (N.D. Ohio 1957), *aff'd in part, rev'd in part*, 274 F.2d 224 (6th Cir. 1959), *cert. denied*, 362 U.S. 989 (1960) (dictum); *General Electric Co.* v. *Hygrade Sylvania Corp.*, 61 F. Supp. 476, 529 (S.D. N.Y. 1944).

other issues entirely,[9] or expressly assume that availability to the public is an element of the word "patented."[10]

In short, if the courts below meant to discard availability to the public from §102 altogether, their decisions are a clear-cut, and seriously harmful, aberration, which this Court should correct at once.

On the other hand, the decisions below are no more defensible if they are limited to subsection (d) of §102. The accepted meaning of "patented" has previously been applied under §102(d). *American Infra-Red Radiant Co.* v. *Lambert Industries, Inc.*, 360 F.2d 977, 991-94 (8th Cir.), *cert. denied*, 385 U.S. 920 (1966). *Ex parte Rackham*, 306 O.G. Pat. Off. 243, 244 (Comm. Pat. 1922), decided under the predecessor to §102(d),[11] held that a foreign patent was not a reference under that provision unless it was "open to the public." The opinions below may be searched in vain for any good reason supporting the creation of internal inconsistency in the meaning of "patented" in a

9. *Sirocco Engineering Co.* v. *B.F. Sturtevant Co.*, 220 F. 137, 142 (2d Cir. 1914), *cert. denied*, 238 U.S. 636 (1915); *Ex parte Gruschwitz*, 138 U.S.P.Q. 505 (Pat. Off. Bd. App. 1961)—both of which deny the necessity of *printing* a foreign patent if it is to be cited as a reference, but do not disturb the requirement of *public availability* (*i.e.*, laying open the patent specification) if it is to be cited as a "patent" at all.

10. *Ritter* v. *Rohm & Haas Co.*, 271 F. Supp. 313, 317, 319 (S.D.N.Y. 1967). *Ritter* held that, in the case of a 1944 French patent, the *délivré* date was the date of patenting under §102(a) because French patents of that era were opened for public inspection on that date. 271 F. Supp. at 318-19. It is undisputed that French practice has since changed, and that the French counterparts of the patents here at issue were not available to the public on the *délivré* date. See Federico, *Foreign Patent Material* (pt. 2), 54 J. PAT. OFF. SOC'Y 147, 157 (1972).

11. Revised Statutes §4887.

crucial statute. Any differences among the policies underlying the different subsections of §102 are amply reflected in the different express provisions which Congress enacted. No court or party below ever suggested any adverse consequences that would flow from giving "patented" its normal meaning in §102(d).

To the contrary, the danger of adverse consequences is created by inconsistency. In a statute fixing time barriers, fundamentally similar to a statute of limitation, inconsistency can produce nothing but mischief.

The inconsistency suggested may appear to find support in two decisions—*In re Talbott,* 443 F.2d 1397 (C.C.P.A. 1971), and *Ex parte Weiss,* 159 U.S.P.Q. 122 (Pat. Off. Bd. App. 1967)—which were relied on strongly by the throwsters below, though not cited by the court of appeals. However, some unconsidered dicta should not be allowed to obscure the holdings of these two cases. Both cases concerned German design patents which had been withheld from the public not, as in this case, by the impartial operation of law, but *by the voluntary choice of the patent applicant*; it was held that these German patents could therefore, despite their secrecy, be used as a reference against the same applicant in the United States.

The principle underlying these two decisions is that one who has voluntarily withheld disclosure of his patent abroad should not be permitted thereby to enlarge his rights in the United States or to toll the running of §102(d). This principle has no application to this case—or to countless other cases in which a patent applicant does not con-

trol the date on which a foreign government discloses his invention to the public.

There is, in short, no justification for the abrupt departure from the established meaning of "patented" which has been sanctioned by the courts below.

B. The Decisions Below Are Contrary to the Philosophy Behind the Patent Laws.

It is not just by accident that availability to the public has been a recognized element of the word "patented" for at least 120 years. Since the early days of the Republic, Congress has implemented the constitutional authority "to promote the Progress of Science and useful Arts" (art. I, §8) through a "contractual" patent system in which availability to the public is a key element.

Our patent system grants an inventor exclusive property rights for a limited time, *in exchange for the inventor's expeditious disclosure of new technology in this country.* The patent "is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions." *Grant* v. *Raymond,* 6 Pet. (31 U.S.) 218, 242 (1832) (Marshall, C.J.). See *Kewanee Oil Co.* v. *Bicron Corp.,* 478 F.2d 1074, 1081-82 (6th Cir. 1973), *cert. granted,* —— U.S. ——, 42 U.S.L.W. 3194 (Oct. 9, 1973) (No. 73-187).

The word "patented" in 35 U.S.C. §102 must be interpreted in a way consistent with this fundamental philosophy. The three subsections of §102 that deal with prior patenting—35 U.S.C. §§102(a), (b), and (d)—all limit the

conditions under which an inventor may trade disclosure for proprietary rights. These sections all deny such rights, under specified circumstances, to an inventor who does not have something new to teach the public.

Thus, §102(a) denies a patent when the invention was available to the public before the applicant's invention whether through knowledge or use by others, description in a printed publication, or a patent. Similarly, subsection (b) denies a patent when the invention was available to the public more than a year before the date of application, whether by description in a printed publication, public use or sale, or—again—a patent. Under both subsections, the teachings of a prior patent must be available to the public before it can bar the inventor from claiming that he has useful knowledge to impart to the public, in return for which he should receive the protection afforded by the patent system.

Subsection (d) addresses itself to the applicant for a United States patent who has previously applied for a foreign patent on his invention. This part of the statute alerts him that the consideration for obtaining United States patent protection is that he, too, must have novel knowledge to impart—and must do so expeditiously. Should he delay the filing of his United States application for more than one year following his foreign filing, he will be foreclosed from United States rights if his invention becomes "patented" abroad before he files his United States application.

The courts below gave to the word "patented" in this subsection an interpretation which makes availability to

the public irrelevant. This interpretation undermines the fundamental policy of §102. Under the decisions below, an applicant whose invention has not been made publicly available, and who thus still has something new to offer, may nevertheless be barred from obtaining a United States patent.

Thus, not only precedent, but the very purpose of the controlling statute, supports the established definition of "patented" which was rejected by the courts below.

C. The Decisions Below Raise and Do Not Resolve Questions Concerning the Validity of Innumerable Patents Which Were First Applied for Abroad.

The decisions below, in disregarding availability to the public and making the accrual of proprietary rights the only test of whether an invention is "patented," not only unjustifiably change and confuse the law; they raise the possibility of consequences that could not have been desired by the courts below.

At the time here in question (and today), proprietary rights accrued in France not on the *délivré* date, as the court of appeals assumes (A2-A3), but at the moment the French application was filed. K. Katzarov, *Manual and Directory on Industrial Property All Over the World* 213 (7th ed. 1970) (beginning of protection is date of filing). Although the court of appeals did not suggest that the date of patenting is the date of filing, and although that position was never advanced by any party below, the logic of the court's opinion seems to require that bizarre result—a

result that ignores the distinction made in §102(d) between the date when a foreign application is "filed" and the date when the invention is "patented" in a foreign country.

Because of the inconsistency between the apparent holding of the courts below (which makes the *délivré* the date of French patenting) and the rationale of the courts below (which would make the application date the date of French patenting), it is now unclear when an invention is patented in France under §102(d). And, since the courts below refer to cases construing §§102(a) and (b), the confusion is not limited to subsection (d).

Moreover, the confusion is not limited to applications which were first filed in France. There are several other countries—including Belgium, Italy, Norway, and Sweden, to name only a few—where proprietary rights accrue to an inventor as of the date of the patent application, although granting and publication occur later. K. Katzarov, *Manual and Directory on Industrial Property All Over the World* 187, 276-77, 322, 372 (7th ed. 1970). The status of all United States patents based on prior filings in such countries is cast in doubt by the decision below.

Conclusion

For the foregoing reasons, the petitioner prays that its petition for a writ of certiorari be granted.

Respectfully submitted,

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January 28, 1974.

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT

No. 73-1357

THE DUPLAN CORPORATION, *et al.*,

Appellees,

versus

DEERING MILLIKEN RESEARCH CORPORATION,

Appellant.

Appeal from the United States District Court for the District of South Carolina, at Spartanburg. Robert W. Hemphill, District Judge.

Argued: June 5, 1973 Decided: September 27, 1973

Before BRYAN, Senior Circuit Judge, and FIELD and WIDNER, Circuit Judges.

Simon H. Rifkind (Butler, Means, Evins and Browne; Paul, Weiss, Rifkind, Wharton and Garrison; Morgan, Finnegan, Durham and Pine; Thomas A. Evins and Robert S. Smith on brief) for Appellant. Paul B. Bell and William K. West, Jr., (Parrott, Bell, Seltzer, Park and Gibson; Willkie, Farr and Gallagher; Leatherwood, Walker, Todd and Mann; Cushman, Darby and Cushman; Haynsworth, Perry, Bryant, Marion and Johnstone; Smith, Moore, Smith, Schell and Hunter; David Rabin; Perrin, Perrin and Mann; John W. Malley, W. Warren Taltavull and Michael R. Abel on brief) for Appellees.

PER CURIAM:

Deering Milliken Research Corporation appeals from an order of the district court granting summary judgment holding two United States patents invalid under 35 U. S. C. §102(d)[1] on the ground that the claimed inventions had been patented in France prior to the applications for the United States patents on applications which had been filed in France more than twelve months prior to the United States applications. Involved are United States Patents No. 3,137,119 and No. 3,382,656 and their French counterparts Nos. 1,267,239 and 1,427,001, respectively.

The primary issue upon this appeal is whether an invention is "patented" in France within the meaning of 35 U. S. C. §102(d) when a decree of issuance is signed by the French Patent Office (the délivré date) or the date that its contents are made available to the public by publication in the Bulletin Officiel de la Propriete Industrielle (BOPI). Additionally, the appellant contends that the invention described and claimed in French Patent No. 1,427,001 is not identical, as a matter of law, to the invention described and claimed in United States Patent No. 3,382,656.

It is conceded that in each instance the application in the United States was filed after the delivery date (délivré) of the French patent, but before it was published in the BOPI. In his original and supplemental opinion and order the district judge carefully analyzed the French patent procedure and concluded that the exclusive rights which

1. 35 U. S. C. §102(d) reads as follows:

"A person shall be entitled to a patent unless—

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, * * *"

the nature of the patent includes and envisions accrue to the inventor in France on the date of delivery rather than on the date of publication.[2] Upon our review of the record and the briefs we agree with the district court that in the context of Section 102(d) under the French procedure délivré is the operative patent date. *See Ritter* v. *Rohm & Haas Company,* 271 F. Supp. 313 (S.D.N.Y. 1967); *Ex parte Gruschwitz,* 138 U.S.P.Q. 505 (Pat. Off. Bd. App. 1961).

We also agree with the conclusion of the district court that French Patent No. 1,427,001 and its United States counterpart No. 3,382,656 are for all intents and purposes identical. The district judge had before him the French patent together with an English translation, and while he noted that the American patent contained more detailed specifications and claims than the French version, he found that this was attributable to the procedural requirements of the United States Patent Office and did not change the basic nature of the invention. The contention of the ap-

2. In his opinion which is reported at 353 F. Supp. 826, the district judge summarized the French patent procedure as follows:

> "In France, the patent office is concerned primarily with (1) novelty and (2) industrial impact. Once a given application has satisfied the filing requirements and been processed, it is ready for delivery (delivré), and some four weeks after delivery it is published in the BOPI. * * * The deliverance date is the date of the signing or facsimile of signing by the patent ministry, or minister, and upon that date, and thereafter, the inventor who receives the patent, at his discretion, may disclose the contents of his application to third parties, for selling or other considerations. The applicant has the right to request a postponement for one year in 'deliverance.' The publication and making available to the public, is the publication of the 'ABREGE descriptive' (summary specification in the official gazette). The moment of publication is considered to be the point of time when the official gazette (BOPI) is brought from the French National Printing Office and physically enters the reading room on the ground floor of the INPI [Institute Nationale de la Propriete Industrielle (French Patent Office)]."

pellant that the American patent contains significant and distinguishing improvements is readily answered by the observation of the Court in *Siemens* v. *Sellers,* 123 U. S. 276, 283 (1887):

> "It is contended by the counsel of the complainants, that the American patent contains improvements which are not exhibited in the English patent. But if this were so, it would not help the complainants. The principal invention is in both; and if the American patent contains additional improvements, this fact cannot save the patent from the operation of the law which is invoked, if it is subject to that law at all. A patent cannot be exempted from the operation of the law by adding some new improvements to the invention; * * *."

Summary disposition by the district court was appropriate and the judgment below is affirmed.

AFFIRMED.

IN THE

DISTRICT COURT OF THE UNITED STATES

FOR THE DISTRICT OF SOUTH CAROLINA

SPARTANBURG DIVISION

THE DUPLAN CORPORATION,
Plaintiff,

v.

DEERING MILLIKEN, INC., DEERING MILLIKEN RESEARCH CORPORATION, MOULINAGE et RETORDERIE de CHAVANOZ, ATELIERS ROANNAIS de CONSTRUCTIONS TEXTILES, and ARCT, INC.,
Defendants.

CONSOLIDATED CIVIL ACTION
No. 71-306

Filed
Jan. 2, 1973
Miller C. Foster, Jr., Clerk

DEERING MILLIKEN RESEARCH CORPORATION,
Plaintiff,

v.

THE DUPLAN CORPORATION and BURLINGTON INDUSTRIES, INC.,
Defendants.

CIVIL ACTION No. 70-968 and
CIVIL ACTION No. 69-1096

THE DUPLAN CORPORATION, *et al.*,
Plaintiffs on the Counterclaim,

v.

DEERING MILLIKEN RESEARCH CORPORATION,
Defendant on the Counterclaim,

and

DEERING MILLIKEN, INC., MOULINAGE et RETORDERIE de CHAVANOZ, ATELIERS ROANNAIS de CONSTRUCTIONS TEXTILES, and ARCT, INC.,
Additional Defendants on the Counterclaim.

ALSO CIVIL ACTION NOS.
68-705; 69-777;
70-14; 70-189;
70-250; 70-295;
70-358; 70-385;
70-386; 70-391;
70-493; 70-622;
70-628; 70-677;
70-683; 71-87;
71-88; 71-89;
71-90; 71-91;
71-92; 71-93;
71-94; 71-95;
71-96; 71-97;
71-98; 71-99;
71-100; 71-101;
71-102; 71-115;
71-126; 71-127; and
71-283.

On February 4, 1972, plaintiff Throwsters, pursuant to the provisions of Rule 56 of the Federal Rules of Civil Procedure, filed in this court a motion for summary judgment of invalidity as to two separate United States patents. The first motion seeks an order of this court declaring invalid and void United States Patent 3,382,656, filed January 3, 1966, and issued May 14, 1968, in the name of Henri Crouzet, (and assigned to Chavanoz) for "False Twist Frames and Method for Texturing Synthetic Filaments," including all claims of the said patent, on the theory that the American patent is invalid under the provisions of 35 U.S.C. 102(d)[1] because the alleged invention of the American patent was first patented by the applicant in France (December 27, 1965) prior to the date of the application in this country (January 3, 1966), and application having been filed in France (November 13, 1964) more than twelve months before the filing in the United States. The French patent in question before the court is plaintiffs' Exhibit No. 638, the same being French Patent 1,427,001.

An identical motion was made to have this court declare invalid U. S. Patent 3,137,119, filed June 14, 1961, issued June 14, 1964, in the name of Henri Crouzet, including all claims of said patent(s) pursuant to 35 U.S.C. 102(d). As to this patent, plaintiffs claim that on June 12, 1961, prior to the date of the application in this country on June 14, 1961, a patent was issued to Ateliers Roannis de Construction Textiles (a French corporation hereinafter

1. 35 U.S.C.A. §102(d) provides: Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States.

referred to as ARCT) on an application filed in France June 8, 1960, more than twelve months before the filing in the United States. (See Exhibit No. 788 which has a copy, in French, of French Patent 1,267,239.)

In addition to seeking a declaration of invalidity, plaintiffs seek to enjoin the defendants from ever again asserting or charging an infringement or seeking to collect royalties on the patents, and ask for attorneys' fees, a return of all royalties previously collected, damages, and other relief.

It is admitted that the defendants, or some of them, have sued the plaintiffs for infringement, and as noted in *Monsanto Co.* v. *Rohm and Hass Co.* (E.D.Pa. 1970), 312 F.Supp. 778, 792, under the decisions of the United States Supreme Court, one who is sued for patent infringement may challenge the validity of the patent on the ground that it was fraudulently procured, or because the patentee was guilty of some other inequitable conduct or bad faith in his proceeding before the patent office. *Walker Process Equipment, Inc.* v. *Food Machinery & Chemical Corp.*, 382 U.S. 172, 86 S.Ct. 347, 15 L.Ed.2d 247 (1965); *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, 65 S.Ct. 993, 89 L.Ed. 1381 (1945); *Hazel-Atlas Glass Co.* v. *Hartford-Empire Co.*, 322 U.S. 238, 64 S.Ct. 997, 88 L.Ed. 1250 (1944); *Keystone Driller Co.* v. *General Excavator Co.*, 290 U.S. 240, 54 S.Ct. 146, 78 L.Ed. 293 (1933). Thus, it is obvious that the plaintiff has the right to pursue the motion which is here for a decision.

For the purpose of this record, we can consider the two American patents as having the same posture and the two French patents as having the same posture, that is, in each instance, the application in the United States was filed after the delivery date of the French patent, but before the French patent was published in the *Bulletin Of-*

ficiel de la Propriete Industrielle (BOPI). It is admitted that in each instance the delivery date of the French patent was prior to the United States application, and the date of publication in the BOPI was after the application was made in the United States. As to each of the American patents, application was made in the name of Henri Crouzet, as inventor. As to each of the French patents, application was made in the name of Ateliers Roannis De Constructions Textiles S.A. over the signature of Leo Soep. Henri Crouzet has been identified throughout the record in this case as an officer and/or president of ARCT, and Leo Soep has been identified as a brevet in patents frequently employed by ARCT to procure the French patents. All of this is a part of the record upon which this court must make its decision.

Initially, this court has to determine whether or not the French patents and the United States patents are, for all intent and purposes, identical. The arguments as to identity, displayed before the court, were only as to United States Patent 3,382,656, and French Patent 1,247,001.[2] The court has before it, and had at the time of the hearing of the motion, a copy of the French Patent 1,247,001, with an English translation, and a copy of U. S. Patent 3,382,656. An examination of the language of French patent 1,247,001, as issued by the Institute Nationale de la Propriete Industrielle (INPI) (French Patent Office) and the patent issued by the U.S. Patent Office 3,382,656, leaves no question but that the patent applied for, in each instance, was for the same and identical improvements in False Twist Frames to Texture Synthetic Yarns. It is true that the language in the American patent contains some additions[3]

2. It is agreed that the ruling of the court as to these patents will apply equally to U. S. Patent 3,137,119 and French Patent 1,267,239.

3. It is apparent that the American Patent Office requires more in the way of proof and explanation in the application, explanation and claims, than does the French Patent Office.

but this does not change the basic nature of the invention (improvement) sought to be patented. The drawing attached to the French patent is a very simple drawing[4] and the drawing attached to the American patent has two figures, Figure One and Figure Two. A comparison of Figure One on the American patent, and the drawing attached to the French patent leaves no doubt but that to identify one is to identify the other, and that the figures on the respective patents represent the same idea or improvement sought to be patented. In addition, counsel for the plaintiffs read into the record of the hearing of the motion a letter from Mr. Soep (of ARCT) to Dr. Norman Armitage (of Deering Milliken Research Corp., hereinafter called DMRC) apparently written and dated in Paris November 8, 1964, containing this language:

> Please find herewith a translation made in Great Britain of a patent application filed in France by our company on the 14th of November, 1964.
>
> We beg you to examine whether a corresponding application should be filed in the United States.
>
> If you choose to file we want you to postpone the filing until the end of the priority period. Of course, you may adopt [sic] the wording in any suitable way; the translation does not seem to be very good.

In an obvious reply to this letter, of date December 12, 1964, Dr. Armitage wrote to Mr. Soep:

> Thank you for sending me with your letter of December 8th a translation of the patent application filed in France by Chavanoz relating to loom improvements. I am passing it along to Walter Mueller for examination of the subject matter and to

4. It appears that a drawing, schematic or otherwise, is not a requirement of French patent law.

> decide whether it will be advantageous to file a corresponding application in the United States prior to November 13, 1965.

It may be that another application was contemplated. If so, this was not pressed or explained by the defendants, in any way, and Soep and Armitage are no longer available for clarification (both Soep and Armitage are deceased). Absent any indication that another invention was contemplated, the court, reconciling the dates in the letters with the dates on the patents before it in connection with this motion, is led to conclude that the inventions under study are those involved.[5]

It is significant that the added language in the American patent does not change the process sought to be patented. The comparative language of the patents is reproduced as Appendix "A" of this Order for the purpose of comparison.

Introduced into the record of the case, and relied upon by plaintiffs' counsel, is the File Wrapper[6] for original Patent 3,382,656. This shows that Moulinage Et Retorderie De Chavanoz, Chavanoz (ISERE) France, a corporation of France, assigned the patent rights or rights of application to Henri Crouzet, of Lorie, France. The principal attorneys shown are Dr. Norman C. Armitage and Walter E. Mueller, with correspondence to be sent to Walter E. Mueller, Post Office Box 1927, Spartanburg, South Carolina. The testimony reveals that both Armitage and Mueller were, at this time, acting for and in the employ of DMRC. On page 9 of the File Wrapper is a statement dated December 17, 1965, over the signature of Henri Crouzet, and which reports a blank at the end, as follows:

5. The letters have been handed to the Clerk and she has been ordered to make them a part of the official record, since they were read without objection; they are now exhibits in the file of the case.

6. Exhibit No. 951.

> I do not know and do not believe this invention was ever known or used before my invention or discovery thereof, or patented or described in any printed publication in any country before my invention or discovery thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that this invention or discovery has not been patented in any country foreign to the United States on an application filed by me or my legal representatives or assigns more than twelve months before this application; and that no application for patent on this invention or discovery has been filed by me or my representatives or assigns in any country foreign to the United States except as follows:
>
> [Blank]

The space indicated after the word "follows" was blank so that the file reflects M. Crouzet's representation that he did not know of the patent about which Soep had written to Armitage. This has an overtone which may bring into play the equity powers of this court, but the issue of law requires immediate attention. The morality of this representation, or misrepresentation, of course, may be discussed later by counsel, if they desire.

Before entering any discussion as to the delivery date or the publication date of the French patent in France, the court takes judicial notice of the fact that the processing of a patent in the United States and the processing of a patent in France greatly differ. In France, the patent office is concerned primarily with (1) novelty and (2) industrial impact. Once a given application has satisfied the filing requirements and been processed, it is ready for delivery (delivré), and some four weeks after delivery it is published in the BOPI. An example of that may be found in the French patent under consideration which

shows, "demandé de le 13 novembre 1961 á 14^h 39^m, à Paris; Delivré pararrété du 27 decembre 1965." (Bulletin Officiel de la Propriete Industriele, no 6 de 1966). The deliverance date is the date of the signing or facsimile of signing by the patent ministry, or minister, and upon that date, and thereafter, the inventor who receives the patent, at his discretion, may disclose the contents of his application to third parties, for selling or other considerations. The applicant has the right to request a postponement for one year in "deliverance." The publication, and making available to the public, is the publication of the "ABREGE descriptive" (summary specification in the official gazette). The moment of publication is considered to be the point of time when the official gazette (BOPI) is brought from the French National Printing Office and physically enters the reading room on the ground floor of the INPI.[7] (Mm. Carpentier cited an example in which, through an accident, the delivery truck coming from the southern part of Paris was unable to make delivery by INPI office closing hours, making it therefore necessary to issue an "Erraturn" notice to correct the publication date).

The thrust of plaintiffs' argument is that, in each instance, upon the delivery date, each French patent was

7. While in Paris sitting as an American court for the purpose of taking live depositions of French witnesses unable to travel to the United States, this court, accompanied by counsel for plaintiffs and for defendants, and an interpreter, visited the French Patent Office. While there, by means of an interpreter, a colloquy was had with a French lawyer of the Patent Office, who was also Director of Public Relations, Madame Carpentier. Because of objections by counsel, Ms. Carpentier was not allowed to give the French definitions of the term "deliverance," "Arrete", or "Abrege descriptif." The court observed then, and later, that he would prefer to have the French Court say when a patent came into being, or when a process became a patented process, rather than have an American Court interpret the impact of the French processing apparati. This was objected to by counsel, and so this court is put in the position of having to interpret, by application of American law, the impact of the activities in France on the French patent in question. This court must interpret the effect of "delivré" and "publication."

issued, and the invention was patented or caused to be patented by the applicant on that date. There is no question but that the French application, in each instance, preceded the application for a patent in this country by more than twelve months, which is one of the two requisites affecting validity under 35 U.S.C.A. 102(d). The contention of the defendants is that the date of publication in the official bulletin, in each instance, is the date the invention was patented, as that completed the French processing of the patent. Defendants contend that until the processing was complete, the invention was not available to the public so as to comprise a date upon which the motion could hang.

Initially, this court must consider what a patent is and what it does. A patent confers upon the owner the right to exclude others from making, using or selling the invention during the life of the patent.[8] *Bell International Corporation* v. *United States* (U.S. Court of Claims, 1967), 381 F.2d 1004, 1010. A patent by its very nature is affected with a public interest. As recognized by the Constitution it is a special privilege, designed to serve the public purpose of promoting the "progress of Science and useful Arts." At the same time a patent is an exception to the general rule against monopolies and to the right of access to a free and open market. *Monsanto Co.* v. *Rohm & Hass Co.*, (CCA 3, 1972) 456 F.2d 592, 598. A patent is a species of property, and gives the patentee exclusive right to make, use and vend the invention of discovery for a limited period. That is to say, it carries for the statutory period "a right

8. 35 U.S.C.A. 154 provides: Contents and term of patent.

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of issue fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

to be free from competition in the practice of the invention." *Transparent-Wrap Machine Corporation* v. *Stokes Company* (1947), 329 U.S. 637, 643, 67 S.Ct. 610, 614. Each patent gives its owner a monopoly in respect to its disclosures, so much and no more. It is the grantor of the exclusive right to manufacture, use and sell the invention which it discloses and the particular invention is what the patent grant protects by the monopoly, not that invention plus some embellishment, improvement, or alternate product or process which also happens to be patented. *Motion Pictures Patent Co.* v. *Universal Film Co.* (1917) 243 U.S. 502, 511-513, 37 S.Ct. 416, 61 L.Ed. 871; *American Securit Co.* v. *Shatterproof Glass Corp.*, 268 F.2d 769, 777 (3rd Cir. 1959). A patent is not the granting of a right to make, use or sell, a grant is only the right to exclude others from making, using or selling the patented device (see 35 U.S.C. §154, infra). A patent is a legitimate monopoly having as its primary purpose the advancement of the arts and sciencies rather than reward to the individual. It is not a certificate of merit, but an incentive to disclosure. *Valmont Industries Inc.* v. *Yuma Manufacturing Co.* (D. Colo. 1969), 296 F.Supp. 1291, 1294. The patent privilege and the reason for its existence leads to the concept of enforcement of this right. Recognizing that the patentee is granted this exclusive right insofar as his invention is concerned, the "heart of this legal monopoly is the right to invoke the State's power to prevent others from utilizing his discovery without his consent." *Zenith Radio Corp.* v. *Hazeltine Research Inc.*, 395 U.S. 100, 135, 89 S.Ct. 1562, 1583, 23 L.Ed.2d 129 (1969).

The question narrows to "upon what date, under the patent processes of France, did ARCT gain the rights which the very nature of a patent includes and envisions." It affirmatively appears to this court that those inventor's exclusive rights which a patent envisions, accrued on the delivery (delivré) date. On that date the inventor-patentee

could sell, trade, publish or otherwise do as he wished. The seal of the ministry was affixed and the making known to the public was a matter which did not impede, change or otherwise limit the right granted on the delivery (delivré date). Of doubtful authority because of its ancient vintage by virtue of the changes in the French patent law, is *Sirocco Engineering Company* v. *B. F. Sturtevant Co.*, (CCA 2 1914), 220 F.Rpt. 137, 143. There the court in speaking on the question of when the process was patented in France said:

> No patent can issue here for that which is patented in a foreign country and it is patented there the moment it is sealed and enrolled. *Iresom* v. *Pierce* (CC) 39 F. 795.

Of value to this discussion is *General Electric Co.* v. *Highgraves Sylvania Corp.*, 61 F.Supp. 476 (S.D. N.Y. 1944), wherein, in construing the effective date of a Belgian patent, the court was constrained to hold that the date Phillip's invention was patented in Belgium was the date of the decree issuing the patent, which was November 30, 1928, and not the date of publication, January 19, 1929. To the same effect is *Sun Rubber Co.* v. *National Latex Products Co.*, 148 F.Supp. 469, 470 (N.D. Ohio 1957), wherein, in construing time for the application of 35 U.S.C.A. 102(b), the court said that an Italian invention was "patented" on the date the patent was granted in Italy, notwithstanding that the patent was not printed until a later date.[9] In *Ritter* v. *Roman Harris Company* (S.D. N.Y. 1967), 271 F.Supp. 313, 317, in construing the meaning of the word patented under the French law, the court stated:

> There is no dispute that, in France, all the rights of a patentee accrue to him on the "delivré" date

9. While this case discusses a ruling under Section 102(b) of Title 35 nevertheless the reasoning would be more appropriate for Section 102(d).

of his patent. On that date the Ministry of Industry grants the application by signing a decree. Soon afterward the patent office notifies the applicant. As of the "delivré" date, the patentee acquires a monopoly right to exclude others and he can sue for infringement. However, unlike American patents, French patents are not published on the same day they are granted. Here, the fact that the Farber application had been granted was not published in the Bulletin Official de la Propriete Industriele (the BOPI) until July 6, 1945 and the text of the patent was not published in printed form until August 28, 1945.

Of significant note in the application of this case to the facts before us is the fact that under 35 U.S.C. 102(d) there is no requirement of "availability to the public." Such requirement has been ascribed to 35 U.S.C. 102(a) and 35 U.S.C. 102(b).

Defendant urges upon the court that the provisions of 35 U.S.C. 102(b) and 35 U.S.C. 102(d) are, in effect, the same. If such were true, the necessity for 35 U.S.C. 102(d) would be eliminated. This court has already noted that 35 U.S.C. 102(b) makes specific reference to publication while there is a patent absence of any reference to publication in 35 U.S.C. 102(d). A careful reading of §§102(a) and 102(b) as contrasted with §102(d) discloses that the former are concerned with patent applications in this country by persons other than the person holding the patent in a foreign country. Section 102(d) however is indisputably addressed to the inventor or his representative who has filed an application and been granted a patent in a foreign country, and then endeavors to patent the *same invention* in this country. Viewed in this light, it becomes clear that the omission of any reference to publication in §102(d) is a meaningful omission, as the inventor or his

representative would have knowledge of the issuance of the patent without any general publication. The requirement of publication in §102(a) and §102(b) is clearly to insure that persons, *other than the inventor or his representative,* are given notice of the existence of the patent.

Defendants also urge upon the court reasoning applied in cases involving secret registrations. Such is *Ex Parte Weiss* (Patent Office Board of Appeals, 1967), 159 U.S. Patent Quarterly 122, *In Re Ekenstam,* 45 CCPA 1022, 256 F.2d 321, and other similar cases. This court does not have, in this case, an issue of secret registration. The line of cases is not controlling.

In this case, the French inventor received from the foreign country the exclusive privilege that his laws provided for on the delivery (delivré) date of each French patent. Therefore, the American invention, in each instance, was first patented or caused to be patented by the applicant, or his legal representatives or his assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States. The American patentee was not entitled to the patent issued him in each instance. Because of the provisions of 35 U.S.C.A. §102(d), each of the American patents is invalid.

The motion to declare invalid the two American patents 3,382,656 and 3,137,119, is granted.

This court will, at some future date, set a hearing and hear counsel on the question of attorneys' fees, damages and related issues.

And It Is So Ordered.

Robert W. Hemphill
United States District Judge

Rock Hill, South Carolina

January 2, 1973.

Appendix A

*French Patent 1,427,001**	*United States Patent 3,382,656*
It is known how to texturize synthetic yarns on false twist frames, i.e., comprising spindles giving the yarns a false twist which goes back up in the heating elements, assuring the setting of the false twist upon further cooling. This texturizing process has been greatly developed in recent years and at the same time the necessary equipment has undergone a considerable evolution.	It is known to texture synthetic filaments on "false-twist" spinning frames, i.e., spinning frames comprising spindles which impart to the filaments a false twist which progresses backwards into a heating element, which set the false twist on subsequent cooling. This texturing method has been very greatly developed in recent years and the equipment required has at the same time undergone a considerable change.
In one of the systems used in this field the yarns undergo heating in contact with stationary convex metal heating elements. Initially, hollow elements had been provided with interior circulation of a fluid heated to a regulated constant temperature. Then, electric current also was used with suitable regulation. The device used was first a curved metal channel, called "umbrella ribs," itself constituting the electric resistance heated by Joule effect. Then this channel was replaced by a curved metal tube previously mounted in an electric resistance. The tubes	In one of the systems employed in this field, the threads undergo the heating in contact with fixed convex metallic heating elements. Initially, hollow elements were provided through which there was circulated a fluid heated at a regulated constant temperature. Subsequently, electric heat was employed also with appropriate adjustment. The device employed was first of all a bent metallic channel, called an "umbrella rib," which constituted in itself the electric resistor heated by the Joule effect. This channel was later replaced by a bent metallic tube connected as before as an

* As translated by Harvard Translating & Editorial Service, 927 Fifteenth Street, N. W., Washington, D. C. 20005 [Exhibit 638-B].

Appendix A

French Patent 1,427,001	*United States Patent 3,382,656*
had the advantage of an easier thermal insulation. All the tubes were joined in series and were carefully calibrated to assure a constant temperature from tube to tube.	electric resistor. Tubes had the advantage that they were more readily thermally insulated. All the tubes were connected in series and were carefully calibrated to ensure a constant temperature from tube to tube.
To measure the temperature and for its regulation, at least one of the tubes of the frame was free of yarn and contained a thermal probe connected to control and regulating instruments.	For measuring the temperature and for adjusting it, at least one of the tubes of a spinning frame was free from filament and contained a temperature probe connected to monitoring and adjusting instruments.
The object of the present invention is a heating tube for false twist frames with a section with several lobes subdividing the tube into several twin channels, one channel containing an electric, elastic probe, whereas the other channels permit the passage of the yarns to be heated. Each active channel is part of a work position with the other usual elements, i.e., particularly, a delivery reel, delivery rolls, a false twist spindle and a receiving reel.	The object of the present invention is to provide a heating tube for "false-twist" spinning frames having a cross-section comprising a number of lobes subdividing the tube into a number of coupled channels, one channel containing a resilient electric probe, while the other channels permit the passage of filaments to be heated. Each active channel forms part of an operating position with the other usual elements, i.e., notably a supply reel, delivery members, a false-twist spindle and a take-up reel.
The invention extends not only to the curved tubes with direct	The invention not only includes bent tubes directly, electrically

French Patent 1,427,001	*United States Patent 3,382,656*
electric heating by resistance, but also to the straight tubes. Heating can also be indirect. In any case, the invention is in no way limited to the following embodiment, but covers any variant in the same spirit. The purpose is a heating element with several parallel channels one of which contains a thermal probe, whereas the others serve for passage of the yarn, the probe being under the same thermal conditions as the yarns.	heated by resistance, but also straight tubes. The heating may also be indirect. In any case, the invention is in no way limited to the following embodiment, but covers any variant in the same spirit. The object is to provide a heating element comprising a number of parallel channels, one of which contains a temperature probe, while the others serve for the passage of filament, the probe being subjected to the same thermal conditions as the filaments.
The system further has the advantage of permitting the multiplication of the production of frames which is obviously governed in the first place by the number of yarn passage channels. With tubes having a section with three lobes, production is doubled for the same working rate. Another advantage is that each working position can be controlled effectively in regard to the thermal conditions.	In addition, the system has the advantage that it permits multiplication of the output of the spinning frames, which is obviously primarily determined by the number of channels for the passage of filament. With tubes having a cross-section comprising a plurality of lobes, particularly three lobes, the output is doubled for the same working speed. Another advantage is that each working position may be effectively controlled in regard to the thermal conditions.
The example of embodiment will make it possible to understand better the invention which is illustrated by the hypothetical drawing on the accompanying sheet.	The embodiment will enable the invention, which is illustrated by the diagrammatic drawing on the accompanying sheet, to be more readily understood.

Appendix A

French Patent 1,427,001	*United States Patent 3,382,656*
In the drawing, there is shown an embodiment with a tube having a 3-lobe section, like a clover leaf. Such a tube can be obtained by passage of a larger tube in a suitable die, deforming the tube.	In FIGURE 1, there is illustrated an embodiment comprising a tube having a three-lobe or "clover leaf" cross-section. Such a tube may be obtained by passing a larger tube through an appropriate die by which the tube is deformed.
The tube of the example, shown in section, comprises 3 channels 1, 2, 3, connected by diaphragms 4, 5, 6, created upon deformation of the initial tube. These diaphragms can be closed by complete locking of the opposite partitions, as in the section shown, but it is not obligatory.	In FIGURE 1, the tube of the example, which is illustrated in section, comprises three channels 1, 2 and 3 connected by diaphragms 4, 5 and 6 created in the deformation of the initial tube. These diaphragms may be closed by complete clamping of the opposed partitions, but this is not essential. *Each of the plurality of lobes or tubes may, of course, constitute separate tubes that are interconnected by a good heat conducting means, such as copper or alloy, or equivalent heat conducting metal means.*
Channel 1 contains a thermal probe connected to control and regulation apparatus making it possible to check the temperature of channel 1 at each moment and to keep it in narrow predetermined limits.	The channel 1 contains a temperature probe connected to monitoring and adjusting devices for checking the temperature of the channel 7 at each instant and maintaining it between predetermined narrow limits.
Channels 2 and 3 contain yarns 8 and 9, undergoing heating.	The channels 2 and 3 contain filaments 8 and 9 which undergo the heating.

Appendix A

French Patent 1,427,001	*United States Patent 3,382,656*
In direct heating by resistance of the tube the temperature is the same everywhere, except for losses by radiation, which can differ slightly, by the three channels, if the thermal insulation is not absolutely uniform.	In the direct resistance heating of the tube, the temperature is the same throughout, subject to losses by radiation, which may differ slightly in the same channels, if the thermal insulation is not absolutely uniform.
	Referring to FIGURE 2 *of the drawing, the filaments 10 and 10' pass from the cones 11 and 11' through guide means 12 and 12' and then through parallel lobes 13 and 13', which in the form shown is curved so that the filaments contact the surfaces of the tubes as they are fed therethrough. In some instances, however, the tubes may be made straight instead of curved and the filaments be caused to contact the sides of the tubes by suitable guide means. The heating tubes that comprise lobes 13 and 13' are connected to tube 14 through heat transfer means 16 with terminals 15 which are connected to a suitable source of electric current for heating the tubes by resistance effect. Lobes 13 and 13' are preferably interconnected by a heat transfer means that is preferably made of the same metal as the lobes, so as to have the same resistance, and is preferably made from a metal known for its high*

French Patent 1,427,001	*United States Patent 3,382,656*

resistance properties, for example, of nickel chrome alloy or metals or alloys of a lower resistance. The applied current is preferably low. The heater tubes 13 and 13′ are interconnected by heat transfer means 16. The tubes may be thermally insulated at least in the areas where the tubes are not connected by enclosing them in a larger tube 17 and 17′ which are cut away to allow the heat transfer means 16 to be joined to the heater tubes, and are lined by an insulating material, for example, vermiculite which fills the space between the inner wall of the large tubes and surfaces of the heater tubes or resistor tubes 13 and 13′. The ends of the large tube 17 are closed by disc 18 and 18′, for example, by a plastic material with an orifice the size of the diameter of tube 13 and 13′.

The filaments after passing through the tubes 13 and 13′ are fed through false twist spindles 9 and 18′ which are rotated by simple means indicated as a belt 20 and is adapted to produce a twist in the filament which feeds back on the filament towards the heating tubes 13 and 13′ until arrested by contact with the fila-

Appendix A

French Patent 1,427,001	*United States Patent 3,382,656*
	ments with the surfaces of such tubes. The temperature of the tubes 13 and 13' is adapted to heat the filaments for setting the false twist. Finally, the filaments 10 and 10' pass through a guide 21 and 21' and are then wound onto spools 22 and 22'. Therefore, by means of this invention at least two yarns and actually many more may be advanced through adjacent parallel lobes of a single tube, or through adjacent individual tubes that are interconnected by a suitable heat transfer means with a means located in an adjacent tube that is also connected by heat transfer means to each of the said other lobes or tubes for measuring and controlling temperature throughout the heater tube system.
(The invention can further comprise the following elements separately or in any combinations: a. The tubes can be heated by any means; b. Direct or indirect electric heating is used; c. The tubes can be straight or curved; d. Particularly, use is made of a curved tube, with direct heating by resistance with a 3-lobe sec-	The invention may comprise in addition the following elements singly or in any combination: (a) The tubes may be heated by any means. (b) Direct or indirect electric heating is employed. (c) The tubes may be straight or bent. (d) There is employed notably a bent tube directly heated by resistance and having a cross-section comprising three lobes, with

French Patent 1,427,001

tion, with or without intermediate partitions. [*This section contained as paragraph two of Claim 1, in French Patent 1,427,001.*])

CLAIMS

1. Improvement in false twist frames for texturizing of synthetic yarns and remarkable in that the frames comprise heating of tubes with several lobes, forming multiple parallel channels one of which contains a thermal probe, connected to control and regulating apparatus, whereas the others serve for the passage of the yarns to be heated individually for setting of the false twist applied by individual spindles upstream from the tubes.

The invention can further comprise the following elements separately or in any combinations:

a. The tubes can be heated by any means;

United States Patent 3,382,656

optionally partitioned intermediate diaphragms.

Each of the individual yarns that are processed by the method and apparatus of this invention may be false twisted by individual spindles or by a single spindle that twists a number of yarns. In the second case, a special yarn guide means is needed so that the plurality of yarns are properly fed into the false-twist spindle.

Having thus described the invention, what is claimed is:

1. In a false-twist apparatus for the crimping of a textile yarn including delivery means for advancing the yarn from supply to takeup and between said delivery means, twisting means and heat setting twist within the yarn, respectively the improvement comprising a heating tube having at least three lobes forming multiple parallel channels, each connected by a heat transfer diaphragm, one of said lobes containing a temperature probe, and at least two other of said lobes serving as passageways for individual filaments, resistance elec-

Appendix A

French Patent 1,427,001	*United States Patent 3,382,656*
b. Direct or indirect electric heating is used;	trical heating means for heating filaments disposed within said lobes, whereby the filaments are individually heated for setting the false twist applied by an individual spindle downstream of the tube.
c. The tubes can be straight or curved;	
d. Particularly, use is made of a curved tube, with direct heating by resistance with a 3-lobe section, with or without intermediate partitions.	
2. False twist frames for texturizing of synthetic yarns and with productivity multiplied by the fact of the simultaneous passage of several yarns in heating tubes, subdivided into twin individual channels.	2. The apparatus of claim 1 wherein the heater tube is arcuate in shape.
	3. The apparatus of claim 1 further characterized in that the tube is straight.
	4. The apparatus of claim 1 wherein the heater tube is comprised of at least four lobes.

References Cited

UNITED STATES PATENTS

2,803,108 8/1957 Stoddard et al. 57—34 XR
2,864,229 12/1958 Seem et al. 57—34
2,869,312 1/1959 Van Dijk 57—34
2,891,375 6/1959 Van Damme et al. 57—34
3,289,400 12/1966 Scragg 57—34

FOREIGN PATENTS

824,942 12/1959 Great Britain

IN THE

DISTRICT COURT OF THE UNITED STATES

FOR THE DISTRICT OF SOUTH CAROLINA

SPARTANBURG DIVISION

CONSOLIDATED CIVIL ACTION No. 71-306

THE DUPLAN CORPORATION,

Plaintiff,

v.

DEERING MILLIKEN, INC., DEERING MILLIKEN RESEARCH CORPORATION, MOULINAGE et RETORDERIE de CHAVANOZ, ATELIERS, ROANNAIS de CONSTRUCTIONS TEXTILES, and ARCT, INC.,

Defendants.

Filed

Feb. 21, 1973

Miller C. Foster, Jr., Clerk

On January 25, 1973, the defendant (Deering Milliken Research Corporation) filed motions for further findings, and amendment of the court's previous finding of summary judgment of invalidity of U.S. Patents 3,137,119 and No. 3,382,656, based on the invalidity exclusion set forth in 35 U.S.C. Section 102(d).[1] The Order referred to was pub-

1. 35 U.S.C. §102(d) provides: Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States.

lished January 2, 1973, and the Clerk entered judgment January 16, 1973, in which the two patents were declared invalid for reasons fully stated in the written Order. To support their motions, defendants filed an affidavit of Henri Crouzet, dated January 22, 1973, in which he made certain averments as to ownership, disclosures, et cetera, as to the French patents involved, and made a solemn declaration that American Patent No. 3,382,656, and French Patent No. 1,427,001 were not the same invention. The court has fully considered this affidavit, and fully considered the arguments of eloquent counsel for the defendants. Also examined are the various authorities cited by movants, and their opponents.

Argument on the motion was heard by this court, in the Rock Hill Division, on December 19, 1972, as to the original motion and on February 13, 1973, as to the later motion to amend the findings. In effect, the later arguments reiterated the arguments previously pursued. Initially, movants asked the court to read into subsection 102(d) some of the language of subsections of 35 U.S.C. 102(a) and (b). Counsel insisted that the meaning of Congress was to include in subsection (d), the words in subsection (a), and "described in a printed publication" which is also contained in 35 U.S.C. 102(b). Such language is not in subsection (d), and this court has neither the right, authority, nor precedent, to read into subsection (d) language which the Congress did not include. The court is of the opinion that if the Congress had meant to include such language in 35 U.S.C. 102(d) it would have been included in express language; there is no inference that Congress omitted the language for any other reason than by design.

Counsel for the movant also insisted that the court read into the statute a provision that the invention should be made "available" to the public. Subsection (d) has no such language, and no such requirement of availability.

This subsection simply says that the invention processed in the foreign country "was first patented or caused to be patented by the applicant or his legal representative or his assigns in a foreign country." Contemplation of such language returns us to the real issue before the court on this motion, and the previous motion, when considering patents.[2] In considering 35 U.S.C. Section 102(d), it must be realized that we are dealing with two patents, one an American patent, and the other a foreign patent. The courts have recognized this for almost a hundred years, and this court recognizes the fact that the Congress never intended to place on the foreign patentee the necessity of complying with American patent laws before this country would recognize the invention as patented by the foreign country. To do so would be an attempt to dictate to the foreign country as to the procedures to be employed in procuring the right to the monopoly, the patent, in that foreign country. Every country has the privilege and duty of prescribing its patent laws. No other country has a right to dictate those processes.

2. December 19th hearing (page 39 of the transcript) Mr. Greenfield argued:

> "The defense of invalidity under Section 4887, specifically 102(d) puts a heavy burden on the defendant. Now, as to key dates there is no dispute. The invention was applied for in France in both cases more than a year before it was applied for in the United States, but the area where we join issue primarily, and I also believe is dealt with; and the argument is dealt with almost entirely is the meaning of the word 'patented.' That is essentially a question of law and I agree with my friends on the other side. We are not—I am not asking your Honor to choose between the delivery date and the approval date. Our argument is somewhat different. Our argument is the argument that the courts have made for more than a century and the Congress has adopted that patented in American law requires two elements. It requires issuance of the patent, and it requires it be made available to the public. It is as true under 102(a). It is as true under 102(b), and it has been expressly held to be true under 102(d)."

Movants cite the case of *Schoerken* v. *The Swift and Courtney and Beacher Co.* (S.D. N.Y. 1881), 7 F. 469, which the court held "the expression patented" in the statute, would seem, from signification of the word, to mean only inventions laid open to the public and protected to the inventors (as distinguished from secret patents). The real issue in that case was whether or not a secret patent would have the same impact as a patent where the monopoly is granted. The patent was a French patent, and the issue is not identical as the issue before this court. Significantly, the opinion uses the word "protected to the inventors"; on the "delivre" date, in France, the invention is protected to the inventor.

Movants also cite *Merrell-Soule Company* v. *Powdered Milk Company* (W.D. N.Y. 1914), 215 F. 922, where the court, in a similar decision, was treating with a German patent. In the opinion we find these words:

> • • • A patentee under the German law secures a certain monopoly rights during the pendency of the application, but • • • full and definite monopoly rights are not secured to him until after the Patent Office decision, when there is a *sealing* or *issuing* of the patent [emphasis added], which is evidenced by the ausgegeben date printed on the face of the patent.
>
> The word "patented" as used in both sections when considered in relation to the issuance of the patent or the period from which the monopoly dates, has no different signification. Upon this point there was evidence by the complainant to show that it is the practice of the United States Patent Office to regard the ausbegegan date of a German patent as the date of the grant, the time from which monopoly runs.

This opinion of the court of the Western District of New York was affirmed by the United States Court of Appeals for the Second United States Circuit (1915), 222 F. 911. That opinion quoted from the case of *Telephone Company* v. *Cushman,* 57 F. 842 (N.D. Ill. 1893), in which the judge said:

> It seems to me clear that the meaning of our own statute is to limit the term of the monopoly so that it shall not exist longer than a previously granted monopoly abroad.
>
> The term "patented" as used in our statutes, does not mean the preliminary proceedings, but the actual issuance of the government speaking the exercise of sovereign will, *investing the patentee with the grant of a monopoly* (emphasis added) [57 F. 845].

It therefore appears to the court that the previous ruling of this court as to the delivre date, which is the key to the decision of the issues here, need not be changed. The question is purely a question of law, and while the "publication date" of a patent may be the significant effective date when using a foreign patent as prior art to invalidate a U. S. Patent, or by someone other than the patentee of the foreign patent (35 U.S.C. 102(a) and 102(b)), the same considerations have no applicability to the situation where the U. S. Patent is being considered under 35 U.S.C. 102(d), and in which it is contemplated that the U. S. patentee's own foreign patent may invalidate the U. S. Patent. Section 102(d) applies to a state of fact where the patentee's manner and procedure of patenting the same invention in a foreign country causes the invalidity of the United States Patent. This is significantly pointed out by the U.S. Patent Office Board of Appeals in *Ex parte Weiss,* 159 U.S. Patent Quarterly 122 (December 18, 1967):

The second question raised by appellant relates to a peculiarity in the German design law (which also exists in the design laws of some other countries). In the normal registration the design deposits are open and available to the public, but the applicant for the registration may, at his own option, deposit the design in a sealed package and have it kept secret. When this is the case the contents are not open to public inspection until after the expiration of the design registration. The design registration involved in the present case was one of these secret registrations. Appellant argues that in accordance with the principle of In re Ekenstam, 45 CCPA 1022, 256 F.2d 321, 734 O.G. 290, 118 USPQ 349, and also citing the early case of Brooks et al. v. Norcross et al., 2 Fish. Pat. Case 661, Fed. Case 1,957 (Mass. 1851), and others, a secret patent cannot be used against an applicant. According to this line of cases a foreign patent which is secret, in that the specification is withheld from public inspection, cannot be used as prior art against applicants for patents or patentees. There are several differences in the situation presented here. In the Ekenstam case, for example, the secrecy was a statutory requirement imposed on the Patent Office independently of any action by an applicant. In the present case the secrecy is one which appellant himself, or his assignee, optionally assumed, and, more importantly, *the decisions referred to all dealt with the use of the secret disclosures as prior art against another, which is not the situation here.*

The identical question involved here arose in an early case, relating to mechanical patents, Gramme Electrical Co. v. Arnoux and Hochhausen Electric Co. et al., 17 F. 838, 1883 C.D. 418, 25 O.G. 193 (N.Y. 1883). The patentee of the United States patent in suit had

obtained a prior patent in Austria and the question arose under the predecessor of 35 U.S.C. 102(d) with respect to the invention having been previously patented in a foreign country. According to the Austrian law of 1852, under which the foreign patent had been obtained, the applicant at the time of applying could request that the specification be kept secret and when this was done the specification was kept secret until the expiration of the patent. *The patentee argued that since the foreign patent was secret it could not be used. The court, however, refused to accept the argument, while recognizing that the Austrian patent fell short of being sufficient to defeat a patent granted to another for an invention made after it was granted, and held that the question of the secrecy or publicity of the foreign patent had nothing to do with the applicability of the particular section of the statute.* [Emphasis added.]

It is obvious that publicity of the foreign patent is not a requisite of the exclusion effected by 35 U.S.C. 102(d). It is also obvious that *monopoly* is a requisite. Monopoly exists here from the time of the "delivre" date of the French patent involved. 35 U.S.C. 102(d) is therefore applicable.

Finally, the movant takes the position that the inventions are not the same. The court has previously treated this in its Order of January 2, 1973, and finds no justification to change the ruling there made.

The motion is denied.

The court having determined that there is no just reason for delaying the entry of the final judgment on the previous ruling, it is ordered and directed that the two American patents, Nos. 3,382,656, and 3,137,119 are invalid, that

DMRC's actions for infringement of these patents is dismissed, and the Clerk should enter judgment immediately.

In keeping with the direction of this court, by statute and 28 U.S.C. 1292(b), this court states its opinion that the Order hereinabove referred to involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the Order may materially advance the ultimate determination of the litigation.

AND IT IS SO ORDERED.

ROBERT W. HEMPHILL
United States District Judge

Greenville, South Carolina

February 20, 1973.

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 73-1357

THE DUPLAN CORPORATION, et al,
Appellees,

versus

DEERING MILLIKEN RESEARCH CORPORATION,
Appellant.

Filed
Nov. 1—1973
William K. Slate, II
Clerk

Appeal from the United States District Court for the District of South Carolina, at Spartanburg, Robert W. Hemphill, District Judge.

ORDER DENYING REHEARING

Upon consideration of the petition for rehearing and of the suggestion for a rehearing in banc,

Now, therefore, with the concurrence and approval of Judge Bryan and Judge Widener, and in the absence of a request for a poll of the entire court as provided by Appellate Rule 35(b),

IT IS ORDERED and ADJUDGED, that the petition for rehearing is denied.

John A. Field, Jr.
United States Circuit Judge

35 U.S.C. §102

Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.